



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,219	07/23/2001	Juha Rasanen	060282.00046	4905
32294 7590 03/28/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT 14TH FLOOR TYSONS CORNER, VA 22182-2700				
EXAMINER				
GARY, ERIKA A				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
03/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/911,219

Applicant(s)

RASANEN, JUHA

Examiner

Erika A. Gary

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/31/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-33, 35-37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-33, 35-37 and 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 39 is objected to because of the following informalities: on page 6, lines 16-17, "is initiated" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 44 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no support in the specification for a computer program embodied on a computer readable medium.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22-33, 35-37, and 39-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dufour et al, US Patent Number 5,878,349 (hereinafter Dufour) in view of prior art made of record in previous Office Actions, Tayloe et al., US Patent Number 5,826,188 (hereinafter Tayloe).

Regarding claims 22, 35, 39, 44, and 46, Dufour discloses a method comprising: detecting a request for specific service, wherein said request for specific service is received from at least one of a first access network and a second access network; accessing information on conditions for the first radio access network and the second radio access network for giving sufficient support for a specific service requested by said request for specific service, analyzing whether or not said first radio access network and said second radio access network meet said conditions; and initiating a handover of said radio transceiver device from said first radio access network to said second radio access network if the conditions are met by the second radio access network but the first radio access network does not, wherein a radio transceiver device capable of operating with the first radio access network and the second radio access network is attached to said first radio access network [figs. 3a, 3b; col. 4: lines 46 – col. 5: line 23].

What Dufour does not specifically disclose is wherein an error procedure is initiated, when it is detected in said analyzing that said requested specific service is not available in any of said networks. However, Tayloe teaches this limitation [fig. 3: col. 8: lines 20-28].

Dufour and Tayloe are combinable because they are from the same field of endeavor, that is, handing off call between first and second radio access networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Dufour to include Tayloe. The rationale for this modification would have been to

notify the user that the request couldn't be fulfilled in order for the user to promptly consider another service request.

Regarding claim 23, Dufour discloses wherein said conditions comprise a condition whether said requested specific service exists in the radio access network [figs. 3a, 3b].

Regarding claim 24, Dufour discloses wherein said conditions depend on each other [figs. 3a, 3b].

Regarding claim 25, Tayloe discloses wherein one of said conditions for the first radio access network is a given amount lower than the corresponding condition for the second radio access network [col. 6: lines 30-48].

Regarding claims 26 and 40, Dufour discloses wherein said method is performed in said radio transceiver device [col. 5: lines 20-23].

Regarding claims 27 and 41, Dufour discloses wherein said method is performed in a network control device [col. 5: lines 20-23].

Regarding claim 28, Dufour discloses informing said radio transceiver device of the fact that a handover to said second radio access network is to be initiated [fig. 3b: ref. 47].

Regarding claim 29, Dufour discloses wherein said radio transceiver device is a dual mode phone which is adapted to be operated in said first radio access network and said second radio access network [col. 4: lines 46-48].

Regarding claim 30, Dufour discloses wherein either said first or said second radio access network is a GSM network [col. 1: lines 15-17].

Regarding claim 31, the Examiner takes Official Notice that it is well known in the art that either said second or said first radio access network could be a UMTS network as the specific network types used is a matter of design choice which lacks criticality to the overall function of the invention.

Regarding claim 32, Dufour discloses wherein said requested specific service is a circuit-switched service [fig. 4a: ref. 51].

Regarding claim 33, Dufour discloses wherein said requested specific service is a packet service [fig. 3a: ref. 31].

Regarding claim 36, Dufour discloses wherein said radio transceiver device is attached to said first radio access network such that it is located in a cell of said first radio access network and connected by air with said first radio access network [fig. 1].

Regarding claim 37, Dufour discloses wherein said radio transceiver device is also located in a cell of said second radio access network [fig. 1].

Regarding claim 42, Dufour discloses wherein said analyzing unit is connected to a database to obtain information regarding said conditions of said requested specific service [figs. 3a, 3b; col. 4: lines 46 – col. 5: line 23].

Regarding claims 43 and 45, Dufour discloses wherein said analyzing unit is configured to analyze whether a subscriber using said radio transceiver device is entitled to use said requested specific service [figs. 3a, 3b].

Response to Arguments

6. Applicant's arguments filed 1/31/08 have been fully considered but they are not persuasive. Applicant argues that the claims are not taught by the combination of Dufour and Tayloe. However, the Examiner respectfully disagrees as Dufour teaches the method for determining what service is requested and handing over between first and second radio access networks based on the request and availability of the service. Tayloe also teaches a method of handing off calls between different radio access networks and is therefore combinable with Dufour. The Examiner maintains that one of ordinary skill in the art would have reasonably modified Dufour to include Tayloe as Tayloe teaches initiating an error procedure when the requested service is not available on any of the networks. Applicant also argues that Dufour does not teach analyzing information regarding supported services. However, it is inherent in Dufour's system that the determination of supported services is still performed, however brief. Further, if a call-set up is initiated, the mobile station is in essence requesting a specific service. As broadly interpreted, the Examiner maintains that the claimed invention is taught by the references.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

/EAG/

March 26, 2008

/Erika A. Gary/

Primary Examiner, Art Unit 2617